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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,768	06/30/2000	Jon Ebbe Brelin	80398P310	2604

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EXAMINER

CHEN, ALAN S

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 09/30/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/607,768

Applicant(s)

BRELIN ET AL.

Examiner

Alan S Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-22, 24-30 and 32-44 is/are rejected.
- 7) ☒ Claim(s) 7, 23 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because misspelling of the word "navigation" in the legend of Figure 4. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 740 and 750. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claims 20 objected to because of the following informalities: line 2 of claim 20 should read, "... for opening a corresponding parent entry". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the second device" in line 2 of claim 12. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 11, 15-22, 24-30 and 32-43 are rejected under 35 U.S.C. 102(b) as being anticipated by TA Document 1999025 to 1394 Trade Association given in the IDS.

In reference to claim 11, TA Document 1999025 discloses a method of embedding information about a root\_list\_ID (Fig. 6.5, block title “Subunit Identifier Descriptor”) within a root list descriptor (the subunit identifier descriptor, Fig. 6.5), comprising reading the extended information field by a controller (Fig. 7.1, extended\_information field).

In reference to claim 15, TA Document 1999025 discloses the method comprising using a descriptor specifier that specifies an entry by list\_ID and object\_ID (page 85).

In reference to claim 16, TA Document 1999025 discloses the method of claim 15, further comprising opening the descriptor using the descriptor specifier (Table 8.12 and 8.13).

In reference to claim 17, TA Document 1999025 discloses the method of claim 15, further comprising embedding information about the parent entry (root) within the descriptor specifier (Table 8.2).

In reference to claim 18, TA Document 1999025 discloses the method of claim 15, further comprising placing the information about the parent entry at an end of a child list (see section 8.4.1.3.3).

In reference to claim 19, TA Document 1999025 discloses the method of claim 17, further comprising reading the information from an extended\_information field (Fig. 7.1).

In reference to claim 20, TA Document 1999025 discloses the method of claim 19, further comprising using a descriptor specifier for opening a corresponding parent entry (Table 8.13 and Fig. 8.26).

In reference to claim 21, TA Document 1999025 discloses a method comprising using a descriptor having a field of a list descriptor ID and an object ID (Fig. 7.3).

In reference to claim 22, TA Document 1999025 discloses a method of claim 21, further comprising placing the parent descriptor info block in an extended\_information field (Fig. 7.3).

In reference to claim 24, TA Document 1999025 discloses a method of claim 21 further comprising embedding information about a parent entry within a list descriptor (Fig. 6.5, Root List Descriptor).

In reference to claim 25, TA Document 1999025 discloses a method of claim 21, further comprising placing the information about the entry in a child list (see section 8.4.1.3.3).

In reference to claim 26, TA Document 1999025 discloses a method comprising embedding a parent descriptor info block within a list descriptor (Fig. 6.5, under Root List Descriptor).

In reference to claim 27, TA Document 1999025 discloses the method of claim 26, further comprising placing a descriptor specifier info block for the parent (root) descriptor in one of a root list descriptor (Fig. 6.5, under Root List Descriptor) and a child list descriptor (Fig. 6.5, under Other List Descriptor).

In reference to claim 28 and 29, TA Document 1999025 discloses the method of claim 27 wherein the root list has a first and second position (Fig. 6.5, under Root List Descriptor, has two entries) and the child list has a third and fourth position (Fig. 6.5, under Other List Descriptor). In both cases, the descriptor specifier can be placed in the last position.

In reference to claim 30, TA Document 1999025 discloses the method of claim 27 further comprising: using a descriptor specifier in a descriptor command for opening a parent entry (Table 8.13).

In reference to claims 32,33,37,38,41,42 and 43, TA Document 1999025 discloses a method using a write descriptor command and specifying the delete subfunction value (see section 8.7.4, 8.7.5 and Table 8.24 value 40<sub>16</sub>) to delete lists and entries.

In reference to claims 34,35,36,39 and 40, TA Document 1999025 discloses a method for updating entries using the write descriptor command and specifying the change subfunction value (see Table 8.24 value 10<sub>16</sub>).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6, 8-10, 13, 14 and 44 are rejected under 35 USC 103(a) as being unpatentable over TA Document 1999025 in view of No. 5,101,494 to Bilski et al (hereafter Bilski).

TA Document 1999025 discloses the 1394 standard that defines the descriptor and info block mechanisms such as opening, reading, writing and manipulation of descriptors, lists and entries.

TA Document 1999025 does not disclose expressly a system and method comprising a bus, the bus connecting a first device to a second device with each device having one of the data structures described in TA Document 1999025.

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Bilski discloses a system comprising: a bus (Fig. 21, element 200); a bus connected to a first device (Fig. 21, element 222); and a second device (Fig. 21, element 224); a data structure within a first device which has a hierarchy of descriptors (Fig. 16) and a second device using at least one data structure in a command (Column 4, line 30 thru Column 5, line 24).

TA Document 1999025 are analogous art because they are from the same field of endeavor in communication between devices and the protocol used in their data transactions.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Bilski invention to incorporate an established command set used to create, read, write, and delete information between devices on an IEEE 1394 (FireWire) network.

The suggestion/motivation for doing so would have been the compatibility with current standards and hence the accessibility to a plethora of FireWire devices that currently exist. Furthermore, there is the advantage of very fast external bus speed that FireWire provides (go to [www.webopedia.com](http://www.webopedia.com) under IEEE 1394).

Therefore, it would have been obvious to combine Bilski with TA Document 1999025 for the benefit of compatibility with the 1394 standard.

***Allowable Subject Matter***

10. Claims 7, 12, 23 and 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is the statement of reasons for the indication of allowable subject matter: The prior art disclosed by the applicant and cited by the Examiner fail to teach or suggest, alone or in combination the ability of a controller to navigate backwards in a descriptor hierarchy.



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***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to :

U.S. Pat. No. 5,359,725 to Garcia et al.

U.S. Pat. No. 5,809,331 to Staats et al.

U.S. Pat. No. 5,828,788 to Chiang et al.

U.S. Pat. No. 6,219,766 to Cadden

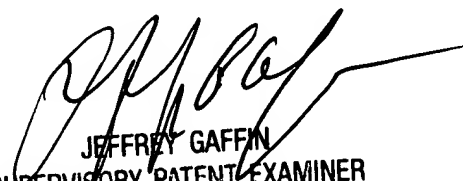
U.S. Pat. No. 6,460,030 to Ludtke

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S Chen whose telephone number is 703-605-0708. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

asc  
09/17/2003

  
JEFFREY GAFFIN  
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